Supreme Court, U. S.
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In The

SUPREME COURT OF THE UNITED STATES

October Term, 1975

No. 75-110

BERNARD A. SAKRAIDA,

Petitioner,

versus

AG PRO, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Fifth Circuit

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OPINIONS BELOW

Three different panels of the court of appeals have handed down decisions in this case as follows: 437 F.2d 99 (1971); 474 F.2d 167 (1973); on rehearing 481 F.2d 668 (1973); ____ F.2d _____, 185 U.S.P.Q. 642 (1975).

JURISDICTION

The jurisdictional requisites are adequately set forth in the Petition.

QUESTION PRESENTED

Whether a valid patent can be issued

for a new combination of old elements which produces a synergistic result that is a vast improvement over anything which previously existed in the particular art.

STATEMENT OF THE CASE

This case involves validity of Gribble and Bennett patent 3,223,070 for a dairy barn construction. The claims in issue define the construction and arrangement of the floor areas of a dairy barn and the means for storing a volume of water on, or immediately above, the floor so that when the water is suddenly released, it will clean all of the barn floor areas without the use of any hand labor. The patented invention for the first time provided a means for thoroughly cleaning all barn floor areas in a matter of a few minutes, where previously it took hours of disagreeable hand labor and the use of large quantities of water to achieve an inferior result (474 F.2d at 169; App. II 84-90, 211-116, 257-59).

In all of the prior appeals and petitions for rehearing, petitioner strenuously argued that the Gribble and Bennett patent should be invalidated because it is admittedly made up of a combination of old elements. The same erroneous argument forms the basis of the present Petition.

REASONS FOR DENYING THE PETITION

1. There is no conflict with the applicable decisions of this Court.

Contrary to petitioner's argument, the cases he relies on expressly recognize that a valid patent can be issued for a combination of old elements where they combine to produce a synergistic result or one which is superior or different from what existed previously. See *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549, 82 L.Ed. 1008, 1010 (1938); *Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152, 95 L.Ed. 162, 166 (1950); *Anderson's-Black Rock v. Pavement Salvage Co.*, 396 U.S. 57, 61, 24 L.Ed.2d 258, 261 (1969). This Court, in *United States v. Adams*, 383 U.S. 39, 51-52, 15 L.Ed.2d 572, 580 (1966) most recently upheld validity of an invention made up of a combination of old elements where the evidence showed, as it does in the present case, that the combination was not obvious to one of ordinary skill in the art.

Graham v. John Deere Co., 383 U.S. 1, 15 L.Ed.2d 545 (1966) set forth the factual determinations which must be made by a court where the defense of obviousness under 35 U.S.C. § 103 has been raised, i.e., (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, and (3) the level of ordinary skill in the pertinent art. The district

court in the present case failed to make any such determinations and literally signed the findings submitted by petitioner without even correcting obvious errors. The court of appeals, however, in its opinion (474 F.2d 169 et. seq.) meticulously reviewed the factual aspects of the case in accordance with the requirements of the *Graham* case and concluded that the Gribble and Bennett patent was valid.

Since 1971 three different panels of the court of appeals have handed down decisions affecting validity of the Gribble and Bennett patent. Before each panel petitioner raised the same arguments as are now presented in the Petition. In each instance the court of appeals declined to invalidate the patent and ultimately upheld it as a valid patent even after granting petitioner the extraordinary remedy of a new trial on allegedly newly discovered evidence. Petitioner's dissatisfaction with these decisions is no basis for granting a petition for writ of certiorari which raises no conflict with the decisions of this Court which have uniformly decided the question presented in the Petition unfavorably to petitioner.

The subsidiary points raised in the Petition of overclaiming and conflict with Rule 52, Fed. R. Civ. P. (Pet. p. 16) are no more well taken than the principal point.

2. There is no overclaiming.

There is no overclaiming because in

order to produce the inventive result, it is necessary to include in the claims the other elements of barn construction along with the floor washing means. The patented combination was new and produced a dramatically different result from anything that had existed previously. As the court said in the *A. & P.* case, 340 U.S. at 150:

> "In the third place, if the extension itself were conceded to be a patentable improvement of the counter, and the claims were construed to include it, the patent would nevertheless be invalid for overclaiming the invention by including old elements, *unless, together with its other old elements, the extension made up a new combination patentable as such.*" [emphasis added]

3. There is no conflict with Rule 52, Fed. R. Civ. P.

The decisions of the court of appeals are not in conflict with Rule 52. In all of its opinions on the merits (437 F.2d 99, 474 F.2d 167, and 185 U.S. P.Q. 642) the court of appeals carefully listed the evidence presented by the parties and came to the firm conclusion each time that the findings of the district court were clearly erroneous and had to be set aside.

CONCLUSION

The Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that three copies of the above and foregoing Brief for Respondent in Opposition have this date been served upon opposing counsel of record by placing same in the United States mail, postage prepaid and properly addressed.

July __, 1975.

J. Pierre Kolisch